

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE MATTHEWS

Appeal No. 98-0673
Application 08/723,355¹

ON BRIEF

Before HAIRSTON, KRASS and LEE, Administrative Patent Judges.
LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from
the examiner's final rejection of claims 6-11 in the involved
reissue application. The original patent contains claims 1-5.

The Rejection on Appeal

¹ Reissue Application filed September 30, 1996, for
Patent No. 5,435,388, filed August 17, 1994, which according
to the appellant is a divisional application of Application
08/051,854, filed April 26, 1993, now Patent No. 5,361,840.

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Claims 6-11 are claims added during the reissue proceeding. They stand finally rejected by the examiner under 35 U.S.C. § 251 as not being drawn to the same invention as that claimed in the original patent.

The Invention

The claimed invention is directed to a ball valve assembly. Representative claim 6 is reproduced below:

6. A ball valve assembly comprising:

a valve case having first and second axial ports defined therein;

a ball rotatably positioned within the valve case, the ball having an axial central opening therein;

a first cable having a first end attached to the ball to rotate selectively the ball to one of a first position and a second position, the first position having the axial central opening of the ball aligned with the axial ports of the valve case and the second position not having the axial central opening of the ball aligned with the axial ports of the valve case, a second end of the first cable being remotely positioned with respect to the valve case.

Opinion

Section 251, United States Code, does not require that claims added by reissue must be drawn to subject matter "claimed" in the original patent. Rather, the reissue

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application must be for the same invention as that "disclosed" in the original patent. 35 U.S.C. § 251.

On the issue of the "same invention" rejection under 35 U.S.C. § 251, the controlling authority is the Federal Circuit's decision in In re Amos, 953 F.2d 613, 21 USPQ2d 1271 (Fed. Cir. 1991). The mere absence of an objective "intent to claim" is not dispositive on the "same invention" question under 35 U.S.C. § 251, and lack of an intent to claim is not an independent basis for denying a reissue application under 35 U.S.C. § 251. In re Amos, 953 F.2d at 618-19, 21 USPQ2d at 1275-1276. The key is whether the disclosure of the original patent is sufficient such that the applicant could have claimed the subject matter now claimed, in the original application for patent. In re Amos, 953 F.2d at 618, 21 USPQ2d at 1275. As is stated in In re Amos, 953 F.2d at 618, 21 USPQ2d at 1274:

Hence, the purpose of the rubric "intent to claim" is to ask the same question as to whether "new matter" has been "introduced into the application for reissue" thus, perforce, indicating that the new claims are not drawn to the same invention that was originally disclosed.

The examiner has failed to demonstrate any reason or basis to find that claims 6-11 add new matter to or are

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otherwise not supported by the original patent disclosure. Note that no rejection for inadequate written description under 35 U.S.C.

§ 112, first paragraph, has been made. The examiner argues that a restriction requirement would have been made in the original patent application had these new claims been presented there. Even assuming that to be true, it does not demonstrate that claims 6-11 add new matter to the original disclosure or otherwise would have been rejectable under any section of the patent statute. Moreover, note that a restriction is not based on any deficiency in the content of the appellant's disclosure.

If the examiner desires to make a restriction requirement, then it is a restriction requirement which should be asserted, not a rejection of the claims for lack of an "intent to claim" under 35 U.S.C. § 251. The appellant can respond to such a requirement in the same way that he could have responded to a restriction requirement made in the original application.

For the foregoing reasons, the rejection of claims 6-11 under 35 U.S.C. § 251 cannot be sustained.

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Conclusion

The rejection of reissue application claims 6-11 under
35 U.S.C. § 251 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
ERROL A. KRASS)	
Administrative Patent Judge)	APPEALS AND
)	
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